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BARNES & THORNBURG
750-17TH STREET NW
SUITE 900
WASHINGTON DC 20006

In re Application of
Kenneth G. Stewart III
Application No. 09/748,281
Filed: December 27, 2001
For: JOIST BRIDGING SYSTEM

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:
: **DECISION ON PETITION**
: **TO WITHDRAW THE**
: **HOLDING OF ABANDONMENT**

This is in response to applicant's petition to withdraw the holding of abandonment filed September 3, 2003 in the United States Patent and Trademark Office (USPTO). There is no fee for this petition.

The petition is **DISMISSED**.

A review of the file record reveals that a Notice of Allowance was mailed to the applicant on July 30, 2002 and the issue fee was received on August 13, 2002. However on January 3, 2003 the application was withdrawn from issue due to the unpatentability of one or more claims under 37 C.F.R. 1.313(b) and a Notice to that effect was mailed to applicant. A Non-final Office action was subsequently mailed on January 22, 2003. Since no response has been received the application has been held abandoned and a notice to that effect was mailed August 27, 2003.

A further review of the file reveals that the Notice to withdraw the case from issue mailed January 3, 2003 and the Non-final Office action mailed January 22, 2003 were sent to the correct address of record:

Barnes & Thornburg
Franklin tower Bldg., Suite 500
1401 Eye Street, N.W.
Washington, D.C. 20005

This is the address given in the original declaration filed with the application. A change of address was filed in this case on March 28, 2003, changing the correspondence address to:

Barnes & Thornburg
750-17th Street N.W.
Suite 900
Washington, D.C. 20006

Because this address change was not made until after the mailing of the Office communications sent January 3, 2003 and January 22, 2003 respectively, they were properly mailed to the correspondence address of record at that time. Because there was no error on

the part of the Office in mailing the Office communications, there was no grounds to re-date and re-mail them upon receipt of the change in correspondence address.

The MPEP 601.03 states,

“Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP code)...”

“The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.”

Because the applicant apparently filed the change of correspondence address after the mailing date of the Office communications there was no apparent Patent and Trademark Office error in their mailing and the holding of abandonment will not be withdrawn.

Given that the applicant failed to change the correspondence address before the mailing of the above noted Office communications it is not surprising that the applicant failed to receive them. While MPEP 711.03(c) does give an applicant the ability to petition to show that a communication from the Patent Office was not received, this is predicated on the fact that applicant was able to receive mail at the correspondence address. MPEP 711.03(c) also requires an applicant to show that “due care was taken to adhere to the requirement for prompt notification in each concerned application for the change of address”. Since applicant was apparently not able to receive mail at the address of record, and the Office communications were correctly mailed to the address of record, the procedure outlined in 1156 OG 53 is not available to the applicant and the alleged showing of non-receipt of the Office action is not persuasive to withdraw the holding of abandonment in this application.

Assuming that the applicant can adequately show that he was at the correct correspondence address at the time the correspondence in question was mailed, the showing required to establish non-receipt of an Office communication must include all of the following requirements:

- (1) A statement from the practitioner stating the Office communication was not received by the practitioner;
- (2) A statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and
- (3) A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The docket records indicated above must include a copy of the list of all responses in the practitioner's office with the due date of April 22, 2003. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 OG 53 (November 16, 1993).

Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(m); and **(3)** a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is \$110. The fee for a petition under the unintentional standard is \$1,330. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: Deputy Commissioner of Patent Examination Policy
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 308-6916
Attn: Office of Petitions

By Hand: Crystal Plaza 4, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Please contact me directly for inquiries specific to this decision.



Steven N. Meyers, Special Program Examiner
Patent Technology Center 3600
(703) 308-3868

SNM/cps: 2/10/04